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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/707,497	12/18/2003	Shwn-Meei Y. Linden	JD-258A US	1496

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EXAMINER	
AHMAD, NASSER	

ART UNIT	PAPER NUMBER
1772	

DATE MAILED: 09/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/707,497	LINDEN ET AL.	
	Examiner	Art Unit	
	Nasser Ahmad	1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 December 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-22* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-22* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *3/22/04, 11/8/04*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1, the phrase "the upper surface" is found to be indefinite for lack of antecedent basis.

Claim 5, the phrase "the lower surface" is found to be indefinite for lack of antecedent basis.

Claim 7, the phrase "the upper removable protective layer" is found to be indefinite for lack of antecedent basis.

Claim Rejections - 35 USC § 102

> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 3, 5, 8-10, 14 and 17-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Nobles (2003/0203165).

At first applicant should note that the effective filing date of this reference is taken to be April 30, 2002 which is the filing date of the provisional application.

Nobles relates to a thin surface modification laminate (100) comprising an indicia containing layer (110) disposed on the upper surface of a base layer or carrier film (105). A bonding coat or adhesive (125) is disposed on the lower surface of the carrier film. As shown in figure-1, an upper protective layer (115) is disposed above the indicia layer. The adhesive is pressure sensitive adhesive (PSA) and is protected by a release liner (page-1, paragraph-[0017]). The carrier is a polymeric film (page-1, paragraph-[0015]). The laminate is disposed on a surface (120) to be modified.

The base coat (claim 17) is understood to be the adhesive (125).

The image can include one or more color layer (page-1, paragraph-[0016]), hence it shows the presence of a second surface modifying laminate disposed above the first modifying laminate.

Also disclosed is a method for modifying a surface comprising applying the laminate to a surface (abstract).

Claim 15, is directed to an intended future use of the laminate and has not been given any patentable weight as it is not found to be of positive limitation.

4. Claims 1-11 and 14-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Scolaro (2003/0134074 or 2003/0152734)

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in

the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Scolaro relates to a surface modifying laminate comprising an indicia (4) containing layer disposed on a surface (2) to be modified (figure-2). As mentioned in paragraph-[0032], the indicia layer can be multi-strata and hence, the bottom layer of the multi-layered indicia is taken to be the carrier film. The thickness of the laminate is 8 mils or less ([paragraph-0034]). The indicia layer can be perforated (figure-3) and its bottom layer is taken to be the perforated carrier film. An adhesive coat is provided on the lower surface with a release liner (18) and a removable upper protective layer (16) to protect the indicia.

Claim 15 has not been given patentable weight because it is directed to an intended future use or treatment of the laminate.

Scolaro also teaches a method for modifying a surface comprising applying a surface modifying laminate to a surface (abstract).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 2, 4, 6-7, 11, 16 and 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nobles in view of Scolaro (2003/0134074 or 2003/0152734).

Nobles, as discussed above, fails to teach that the upper protective layer is removable. Scolaro discloses a surface modifying laminate (figure-5) including an upper protective layer (16) that is removable to provide for displaying a clean image by replacing said layer. Therefore, it would have been obvious to one having ordinary skill in the art to utilize Scolaro's teaching of using a removable protective upper layer in the invention of Nobles with the motivation to provide for displaying clean indicia.

Scolaro further teaches that the thickness of the laminate is 8 mils or less (page-4, paragraph-[0034]). As shown in figure-2, the top coat (8) is disposed over at least a portion of the surface modifying laminate and over at least a portion of the adjacent surface to maintain the laminate in-place. The base coat or adhesive can be applied prior to the application of the laminate.

When the indicia is multi-strata (page-3, paragraph-[0032]), then the perforated bottom layer can be the carrier film. Figure-3 shows a perforated indicia layer.

7. Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being obvious over Scolaro (2003/0134074 or 2003/0152734).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject

matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2).

Scolaro, as discussed above, fails to teach that the carrier film carries at least one and no more than 200 perforations per sqft. It would have been obvious to one having ordinary skill in the art to modify scolaro by providing at least one and no more than 200 perforations per sqft. , based on optimization through routine experimentation, to provide for optimum adherence and removability from the applied surface.

Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 1-22 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-28 of copending Application No. 10/322973. Although the conflicting claims are not identical, they are not patentably distinct from each other because both the instant application and application No. 10/322973 are directed to a surface modifying laminate having the indicia containing layer. However, Application'973 fails to show the presence of a carrier film for the indicia layer. The application'973, in paragraph-[0032), recites that the indicia layer is made up of multiple strata or layer. Therefore, it would have been obvious to one having ordinary skill in the art that the lower layer of the strata would provide for the function of a carrier film.

Further, the presence of perforations is disclosed in paragraph-[0033].

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

10. Claims 1-22 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-21 of copending Application No. 10/707499. Although the conflicting claims are not identical, they are not patentably distinct from each other because both the applications are directed to a surface modifying laminate structure comprising a carrier film with an indicia disposed thereon. However, application'499 teaches that the indicia is on the lower surface of the carrier, but fails to teach that indicia is located on the upper surface

of the carrier. It would have been obvious to one having ordinary skill in the art to modify application'499 by providing the indicia on the upper surface, instead of the lower surface, because such a modification would have involved mere rearrangement of the components. *In re Japikse*, 86 USPQ 70.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nasser Ahmad whose telephone number is 571-272-1487. The examiner can normally be reached on 7:30 AM to 5:00 PM, and on alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nasser Ahmad 9/4/05
Primary Examiner
Art Unit 1772

N. Ahmad.
September 4, 2005.